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No. 93 - 862

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1993

BELLSOUTH ADVERTISING
& PUBLISHING CORPORATION,
Petitioner,

v.

DONNELLEY INFORMATION PUBLISHING, INC., AND
THE REUBEN H. DONNELLEY CORPORATION,
Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

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MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF OF MARTINDALE-HUBBELL, INC. AS AMICUS CURIAE IN SUPPORT OF PETITIONER BELLSOUTH ADVERTISING & PUBLISHING CORPORATION

WILLIAM J. DUNAJ
Mershon, Sawyer, Johnson,
Dunwody & Cole
Suite 4500
First Union Financial Center
200 South Biscayne Boulevard
Miami, FL 33131-2387
(305) 358-5100

Attorneys for Martindale-Hubbell, Inc.

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MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE*

Martindale-Hubbell, Inc. ("Martindale-Hubbell") hereby respectfully moves for leave to file the attached brief as *amicus curiae* in this case. The consent of the attorney for Petitioner, BellSouth Advertising & Publishing

Corporation ("BAPCO"), has been obtained.* The consent of the attorney for Respondents, Donnelley Information Publishing, Inc. and The Reuben H. Donnelley Corporation (collectively "Donnelley"), was requested but refused.

The interest of Martindale-Hubbell in this case arises from the fact that annually Martindale-Hubbell publishes the Martindale-Hubbell Law Directory. This Law Directory contains, *inter alia*, a roster, as complete as possible, of the Bar of the United States and Canada, plus listings for lawyers in the United States Pacific and Other Territories, listings for lawyers registered to practice Patent Law before the U.S. Patent and Trademark Office and to practice Canadian patent law, listings for lawyers employed by the Federal Government in Washington, D.C.,

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* The written consent of Petitioner is being filed with the Clerk of the Court contemporaneously herewith.

and listings of international lawyers whose professional interests extend beyond their own countries. These listings appear in the Geographical Section of seven volumes of the Martindale-Hubbell Law Directory.

Martindale-Hubbell creates the Law Directory by directly contacting attorneys through mailings as well as through its field representatives, and having those attorneys complete questionnaires to provide the information which appears in the Directory. Martindale-Hubbell also engages in a continual and elaborate effort to update the data in the Directory and to monitor the status of attorneys listed therein. Among other things, it directly communicates with state bars and/or admitting authorities in the United States and Canadian Provinces, as well as local Bar associations, and obtains lists of new attorneys, changes in Bar membership,

notices of deceased attorneys, notices of discipline, suspension and reinstatements, it reviews annual Bar rosters and state and local Bar publications, and it monitors attorney advertising regulations and state specialization programs.

Each volume of the Martindale-Hubbell Law Directory is published with a copyright notice in accordance with the copyright act. Martindale-Hubbell registered the copyrights in its law directories and received certificates of registration from the Copyright Office. Martindale-Hubbell is the owner of the copyrights and the copyright registrations in the Martindale-Hubbell Law Directory.

Martindale-Hubbell presently has pending a case styled Martindale-Hubbell, Inc. v. Dunhill International List Company, Inc., United States District Court for the Southern

District of Florida, Case No. 88-6767-CIV-ROETTGER. That case was brought by Martindale-Hubbell against Dunhill (a mail list company) for, *inter alia*, infringement of Martindale-Hubbell's copyrights in the Martindale-Hubbell Law Directory.

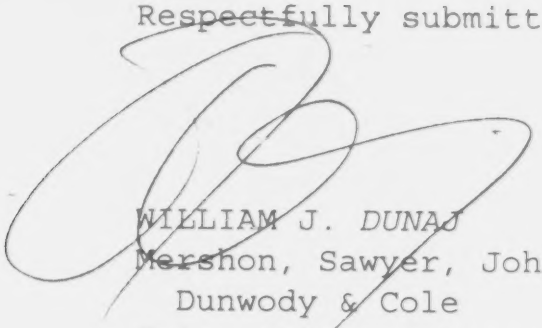
Martindale-Hubbell and Dunhill filed cross-motions for summary judgment on the copyright issues. Recently, the magistrate in that case issued a "Report And Recommendation To District Judge" wherein it was found that Dunhill had not copied any original constituent elements of the Martindale-Hubbell Law Directory. The magistrate's decision was based in large part upon the Eleventh Circuit's en banc decision in *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 999 F.2d 1436 (11th Cir. 1993)(the case below).

Martindale-Hubbell is interested in a proper interpretation of the copyright law since it relies heavily on copyright protection for the Martindale-Hubbell Law Directory. If the en banc Eleventh Circuit decision below is permitted to stand, other mail list companies and other competitors may be able to copy the Martindale-Hubbell Law Directory with impunity in the Eleventh Circuit. The en banc decision may also encourage courts in other circuits to adopt the approach of the Eleventh Circuit in the case below. This will inevitably lead to confusion and a lack of clarity as to the scope of copyright protection, if any, for Martindale-Hubbell's Law Directory throughout the country. Such a result would seriously and irreparably damage Martindale-Hubbell's publishing business.

Petitioner, BAPCO, has argued a number of issues supporting grant of *certiorari* in this case and only briefly discusses the standard by which creativity should be measured. The brief that Martindale-Hubbell is requesting permission to file as *amicus curiae* focuses on that issue and contains a more complete argument of the correct standard by which creativity of works of authorship should be measured. This argument should be helpful to

the Court in determining whether to grant *certiorari* in this case.

Respectfully submitted,



WILLIAM J. *DUNAJ*
Mershon, Sawyer, Johnston,
Dunwody & Cole
Suite 4500 Southeast
Financial Center
200 South Biscayne
Boulevard
Miami, FL 33131-2387
(305) 358-5100

Attorneys for Martindale-Hubbell, Inc.

TABLE OF CONTENTS

Page

TABLE OF CONTENTS.....i

TABLE OF AUTHORITIES.....iii

PRELIMINARY STATEMENT.....2

INTEREST OF MARTINDALE-HUBBELL AS *AMICUS CURIAE*.....2

STATEMENT OF THE CASE.....9

SUMMARY OF THE ARGUMENT.....12

ARGUMENT.....16

I. THIS COURT SHOULD RESOLVE THE IMPORTANT QUESTION OF THE PROPER STANDARD BY WHICH CREATIVITY OF WORKS OF AUTHORSHIP SHOULD BE MEASURED UNDER THE COPYRIGHT ACT 16

A. The Legislative History of the Copyright Act of 1976 Indicates that Originality is to be Measured by the Standards then Applied by the Courts.....17

B. This Court's Ruling in *Feist Publications, Inc. v. Rural Telephone Service Co.* does not provide sufficient guidance as to when a minimal degree of creativity is present.....21

C. This Court should grant *certiorari* to clarify the

TABLE OF CONTENTS

Page

requirement of creativity as stated in *Feist* as being based upon clearly defined objective standards 28

II. THE EN BANC DECISION OF THE ELEVENTH CIRCUIT BELOW IN *DONNELLEY* HAS ESTABLISHED A DEGREE OF CREATIVITY WHICH IS BOTH TOO HIGH AND IS MEASURED BY SUBJECTIVE ANALYSIS 30

III. THIS IS AN APPROPRIATE CASE FOR *CERTIORARI* SINCE THE REQUIREMENT OF CREATIVITY IS NOT LIMITED TO COMPILATIONS 35

CONCLUSION 38

TABLE OF AUTHORITIES

Cases ..... **Page**

BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 719 F. Supp. 1551 (S.D. Fla. 1988) ... 11, 32

BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 933 F.2d 952 (11th Cir. 1991) 11

BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 999 F. 2d 1436 (11th Cir. 1993)(en banc) *8, 33*

Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, (1903) 28, 35

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282 (1991) ..... 16, 17, 21, 22, 23, 24 ..... 25, 26, 27, 29, 34, 35

TABLE OF AUTHORITIES

Cases.....**Page**

Constitutional and Statutory Provisions

17 U.S.C. § 101.....12

17 U.S.C. § 102(a).....19, 36, 37

Other

Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong., 1st Sess. 9 (Comm. Print 1961).....18

Copyright Law Revision, Pt. 3: Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft, 88th Cong., 1st Sess. 40-41 (Comm. Print 1964).....19

Copyright Law Revision, Pt. 6: Supplementary Report of The Register of Copyrights on the General revision of the U.S. Copyright Law, 1965

TABLE OF AUTHORITIES

Cases ..... **Page**

Revision Bill, 89th Cong., 1st Sess. 3 (Comm. Print 1965) 20

A. Latman & J. Lightstone, *The Kaminstein Legislative History Project: A Compendium and Analytical Index Leading to the Copyright Act of 1976*, (1981) 20

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BRIEF OF MARTINDALE-HUBBELL, INC. AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER BELLSOUTH ADVERTISING & PUBLISHING CORPORATION

PRELIMINARY STATEMENT

Martindale-Hubbell, Inc. ("Martindale-Hubbell") submits this brief as *amicus curiae*, pursuant to Rule 37 of the Rules of this Court, in support of Petitioner, BellSouth Advertising & Publishing Corporation ("BAPCO").

INTEREST OF MARTINDALE-HUBBELL AS *AMICUS CURIAE*

Established in 1868, the Martindale Company issued Martindale's United States Law Directory and Martindale's American Law Directory, prior to purchasing the publishing rights to Hubbell's Legal Directory in 1930. Since 1930, Martindale-Hubbell, Inc. has created and published annually a directory of lawyers known as the Martindale-Hubbell Law Directory. This Law Directory contains, *inter alia*, a roster, as complete as possible, of

the Bar of the United States and Canada, plus listings for lawyers in the United States Pacific and Other Territories, listings for lawyers registered to practice Patent Law before the U.S. Patent and Trademark Office and to practice Canadian patent law, listings for lawyers employed by the Federal Government in Washington, D.C., and listings of international lawyers whose professional interests extend beyond their own countries. These listings appear in the Geographical Section of each volume of the Martindale-Hubbell Law Directory. For each individual attorney listed in the Martindale-Hubbell Law Directory, the data will include: year of birth, year of original bar admission, college and law school attended with degrees received from each, and firm or business affiliation or address. For professional card subscribers, the listings may include, in addition to the

firm's name and address, some or all of the following information: cable address; telephone and telex numbers; names of partners, associates or counsel; firm size and composition; fields of law in which the firm concentrates; any specialties of firm practice, if permitted in the jurisdiction where it is located; any language proficiency on the part of the firm's partners, associates or counsel; references to any branch offices the firm may have; and the names of up to ten clients and/or other references. The Biographical Section provides expanded personal data for lawyers and firms and a listing of up to 40 clients and/or references.

Martindale-Hubbell creates the Law Directory by directly contacting attorneys through mailings as well as through its field representatives, and having those attorneys complete questionnaires to provide the

information which appears in the Directory. Martindale-Hubbell also engages in a continual and elaborate effort to update the data in the Directory and to monitor the status of attorneys listed therein. Among other things, it directly communicates with state bars and/or admitting authorities in the United States and Canadian Provinces, as well as local Bar associations, and obtains lists of new attorneys, changes in Bar membership, notices of deceased attorneys, notices of discipline, suspension and reinstatements, it reviews annual Bar rosters and state and local Bar publications and it monitors attorney advertising regulations and state specialization programs.

Each volume of the Martindale-Hubbell Law Directory is published with a copyright notice in accordance with the copyright act. Martindale-Hubbell registered the copyrights

in its law directories and received certificates of registration from the Copyright Office. Martindale-Hubbell is the owner of the copyrights and the copyright registrations in the Martindale-Hubbell Law Directory.

Martindale-Hubbell presently has pending a case styled Martindale-Hubbell, Inc. v. Dunhill International List Company, Inc., United States District Court for the Southern District of Florida, Case No. 88-6767-CIV-ROETTGER. That case was brought by Martindale-Hubbell against Dunhill for, *inter alia*, infringement of Martindale-Hubbell's copyrights in the Martindale-Hubbell Law Directory. Dunhill extracted the names and addresses of lawyers from the 1981 and 1988 editions of the Martindale-Hubbell Law Directory. Dunhill then utilized this

material to assemble mailing lists of lawyers and law firms nationwide.

Dunhill employed temporary help to review the biographical section of the Martindale-Hubbell Law Directory and to extract the names, business addresses, and zip codes of attorneys working in law firms. Notations were also made of attorney age and area of specialization. This material was then encoded into Dunhill's computer to enable it to include on a given mailing list only those individuals meeting the specific criteria of its customers. Dunhill's temporary employees also examined the geographical roster section for names and addresses, taking approximately half of the copied attorney names from the geographic section and half from the biographical section. In total, Dunhill copied approximately 390,000 of the 700,000 attorney names and addresses from the 1988

edition of the Martindale-Hubbell Law Directory. Dunhill sold its mailing lists based upon the material copied from the Martindale-Hubbell Law Directory for commercial profit and gain.

Martindale-Hubbell and Dunhill filed cross-motions for summary judgment on the copyright issues. Recently, the magistrate in that case issued a "Report And Recommendation To District Judge" wherein it was found that Dunhill had not copied any original constituent elements of the Martindale-Hubbell Law Directory. The magistrate's decision was based in large part upon the Eleventh Circuit's en banc decision in *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 999 F.2d 1436 (11th Cir. 1993)(the case below).

Martindale-Hubbell is interested in a proper interpretation of the copyright law

since it relies heavily on copyright protection for the Martindale-Hubbell Law Directory. If the en banc Eleventh Circuit decision below is permitted to stand, other mail list companies and other competitors will be able to copy the Martindale-Hubbell Law Directory with impunity in the Eleventh Circuit. The en banc decision may also encourage courts in other circuits to adopt the approach of the Eleventh Circuit in the case below. This will inevitably lead to confusion and a lack of clarity as to the scope of copyright protection, if any, for Martindale-Hubbell's Law Directory throughout the country. Such a result would seriously and irreparably damage Martindale-Hubbell's publishing business.

STATEMENT OF THE CASE

Petitioner, BellSouth Advertising & Publishing Corporation ("BAPCO"), is the

world's largest publisher of yellow pages classified directories. In 1984, BAPCO published the Greater Miami Yellow Pages directory. Donnelley obtained a copy of BAPCO's Miami Yellow Pages and had certain material contained therein copied into a computer database by a keying service. Donnelley stipulated that it had keyed into the computer database every listing (a listing comprises a name, address and telephone number) contained in the Miami Yellow Pages. For each listing, Donnelley also stipulated that it keyed a code for the classified heading under which the listing appeared, a code for the size of the advertisement, and a code for the directory from which the listing was keyed. Later, the code for the classified heading was translated back into the words of the corresponding heading. Therefore, when Donnelley's database was completed, it

contained every listing and its corresponding classified heading as they appeared in the Miami Yellow Pages directory. The computer database was then used by Donnelley to prepare sales lead sheets which were used by Donnelley to sell advertising in its own directory. Donnelley also used the material in the copied computer database to publish its yellow pages directories.

In October 1985, BAPCO sued Donnelley for, *inter alia*, infringement of BAPCO's registered copyrights in the Miami Yellow Pages. The district court granted BAPCO's motion for partial summary judgment on the copyright issue. *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 719 F. Supp. 1551 (S.D. Fla. 1988). A three judge panel of the Eleventh Circuit affirmed the decision of the district court. *BellSouth Advertising & Publishing*

Corp. v. Donnelley Information Publishing, Inc., 933 F.2d 952 (11th Cir. 1991). The panel decision was reviewed en banc more than eighteen months later. The en banc Eleventh Circuit reversed the decision of the district court. One judge of the en banc Eleventh Circuit dissented. BAPCO filed the present Petition for *certiorari* on November 30, 1993.

SUMMARY OF THE ARGUMENT

In order for works of authorship to qualify for copyright protection, they must meet the statutory requirements of the Copyright Act of 1976. Yellow pages directories, such as those involved in the present case, qualify for copyright protection as compilations. The statute defines a compilations as follows:

> A "compilation" is a work formed by the collection and assembling of pre-existing materials or of data that are

> selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

17 U.S.C. § 101. The term "original" has been construed by this Court to include the requirement of a minimal degree of creativity. The legislative history of the Copyright Act further indicates that no requirement of aesthetic value, novelty, or ingenuity should be applied when assessing creativity.

The en banc decision of the Eleventh Circuit below concluded that the compilation of names, addresses, telephone numbers and classified headings in BAPCO's Miami Yellow Pages was not sufficiently creative, and, therefore, not original, as a matter of law. Consequently, it was determined that the Miami Yellow Pages did not meet the requirements of

the statute and copyright protection for the compilation was denied.

However, the en banc Eleventh Circuit below erred in analyzing the creativity associated with the Miami Yellow Pages directory because it assessed creativity on a qualitative basis. It is submitted that creativity should be assessed according to an objective standard, rather than qualitatively. Qualitative analysis of creativity is contrary to the intent of the Copyright Act as reflected by the legislative history, and also contrary to other Supreme Court precedent.

The en banc Eleventh Circuit below further erred by determining the degree of creativity present in the Miami Yellow Pages by comparing it to other similar directories. In so doing, the court applied a patent law standard of novelty or obviousness. This Court has clearly stated that novelty and

obviousness are not the proper measure of creativity required for copyright protection. Therefore, the en banc Eleventh Circuit below erroneously concluded that the Miami Yellow Pages did not possess the requisite degree of creativity to qualify for copyright protection. This Court should grant the present Petition for *certiorari* in order to clarify the manner in which creativity is to be measured.

Although the issue of how to measure the proper degree of creativity required for copyright protection arises in the present case in the context of yellow pages directories, the requirement of originality, and, therefore, creativity applies to all copyrighted works of authorship. This case is therefore not fact specific, but, rather, relates to a rule of law which is applicable to copyright law generally. Accordingly, this

case is appropriate for review by this Court. For these reasons, Martindale-Hubbell submits that the Petition for certiorari should be granted.

ARGUMENT

I. THIS COURT SHOULD RESOLVE THE IMPORTANT QUESTION OF THE PROPER STANDARD BY WHICH CREATIVITY OF WORKS OF AUTHORSHIP SHOULD BE MEASURED UNDER THE COPYRIGHT ACT

In *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991), this Court emphasized one aspect of compilation copyright law, but in so doing raised a number of other questions that remain unanswered. Although *Feist* emphasized the need for creativity for a work of authorship to qualify for copyright protection, it did not set any guidelines by which that level of creativity could be determined. The en banc Eleventh Circuit decision below, while ostensibly relying on

Feist, based its decision on a qualitative analysis of the level of creativity. Furthermore, that decision established a level of creativity exceeding that established by this Court in *Feist*. Martindale-Hubbell submits that this Court should grant the present Petition in order to resolve the important question in copyright law of what guidelines should be used to determine the minimal level of creativity.

A. The Legislative History of the Copyright Act of 1976 Indicates that Originality is to be Measured by the Standards then Applied by the Courts

In order for the Copyright Act to provide reliable protection for works of authorship, it should be possible to determine with some reasonable degree of certainty what works qualify for copyright protection. Such certainty cannot be achieved if copyright ability is judged on a qualitative basis. A

qualitative determination of copyright ability places the courts in the awkward position of determining whether the creative contributions of an author are sufficiently worthy to merit protection under the copyright statute. This undesirable result was specifically recognized by the legislature as the Copyright Act of 1976 was being enacted.

The Register of Copyright's 1961 report to Congress, which initiated revision of the 1909 Act, proposed that the statute hinge copyright ability on "original creative authorship." *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, 87th Cong., 1st Sess. 9 (Comm. Print 1961). While this proposed standard was understood by the Register to allow the copyright "of all the classes of works now included" *(Id.)*, the proposal nevertheless drew opposition on the

ground that "the word 'creative' might possibly be understood by courts as implying a higher requirement of creativity than is required at present." *Copyright Law Revision, Pt. 3: Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft*, 88th Cong., 1st Sess. 40-41 (Comm. Print 1964) (remarks of Mr. Goldman). *See id.* at 65 (remarks of Ms. Ringer).

The Register accordingly dropped the word "creative" from the draft legislation, offering in its place a basic provision that in substance is identical to existing Section 102(a). *Id.* at § 1(a) at 1. The Register also proposed a provision addressing the copyright ability of compilations that was identical in substance to existing Section 103 (see *Id.* at § 2, at 1-2), along with a definition of "compilation" that tracks the one in existing Section 101. *See Id.* at § 2(c), at 2.

Commenting on these proposals, the Register again explained that "our intention here is to maintain the essential standard of originality without implying any further requirement of aesthetic value, novelty, or ingenuity." *Copyright Law Revision, Pt. 6: Supplementary Report of The Register of Copyrights on the General revision of the U.S. Copyright Law, 1965 Revision Bill*, 89th Cong., 1st Sess. 3 (Comm. Print 1965). While disputes over other issues delayed passage of the Act for another decade, the language of the relevant portions of Sections 101, 102, and 103 remained unchanged. *See* A. Latman & J. Lightstone, *The Kaminstein Legislative History Project: A Compendium and Analytical Index Leading to the Copyright Act of 1976*, at 29-55, 69-81 (1981).

Thus, the drafters of the present Copyright Act understood the pitfalls presented by the concepts of aesthetic value,

novelty and ingenuity as they are applied to copyright protection. Therefore, they chose to avoid the introduction of the word "creative" within the statute, and, chose instead to rely upon the standard of originality previously applied by the courts; no additional requirement of aesthetic value, novelty or ingenuity was to be implied.

B. This Court's Ruling in *Feist Publications, Inc. v. Rural Telephone Service Co.* does not provide sufficient guidance as to when a minimal degree of creativity is present

In Feist, this Court made it clear that the standard for copyrightability is "originality." "The *sine qua non* of copyright is originality. To qualify for copyright protection, a work must be original to the author." *Feist*, 111 S. Ct. at 1287. According to the Court, "originality" is established by a two-part test: "Original, as the term is

used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity." *Id.* at 1287.

Thus, after *Feist* all copyrighted works, including compilations, are to be measured by a two-part test to determine whether they are original: (1) they must be independently created by the author, and (2) they must possess some minimal degree of creativity. If a compilation meets these two requirements (and otherwise meets the requirements of the statute), it is entitled to copyright protection.

The first element of originality is easily determined -- either a work is independently created by the author or it is not -- this is a factual determination well suited for the trier of fact. However, the

second element, *i.e.*, a minimal degree of creativity, is not so easily determined. Although *Feist* established the requirement for a minimal degree of creativity, it failed to provide any guidelines as to how to determine when that minimal level of creativity was present.

In *Feist*, this Court repeatedly stated that the amount or degree of creativity required in a copyrightable compilation is quite low. The Court said: "[T]he requisite level of creativity is *extremely low; even a slight amount will suffice*. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be." *Id.* (citing M. Nimmer & D. Nimmer, Copyright § 1.08[C][1]) (1990)(emphasis added).

While not every selection, coordination, or arrangement will qualify, as is clear from

the Court's holding regarding the white page alphabetical directory in *Feist*, only minimal creativity is required for a copyrightable compilation. Consider the following key passage which contains the single most important statement about how courts are to judge the creativity component in measuring compilations:

> [T]he originality requirement is not particularly stringent. A compiler may settle upon a selection or arrangement that others have used; novelty is not required. Originality requires only that the author make the selection or arrangement independently (i.e., without copying that selection or arrangement from another work), and that it display some minimal level of creativity. Presumably, the vast majority of compilations will pass this test, but not all will. There remains a narrow category of works in which the creative

> spark is utterly lacking or so trivial as to be virtually nonexistent.

Id. at 1294.

Applying these criteria for copyright protection to the facts in *Feist*, the Court found that the alphabetical arrangement of the names, addressees, and telephone numbers of all of Rural's subscribers in its white pages directory did not meet the creativity component of the originality test. Specifically, the Court found that Rural only performed one act of selection in publishing its white pages directory -- Rural selected to publish all of its subscribers in a single directory -- but concluded that this act of selection was not creative.

> Rural's selection of listings could not be more obvious: it publishes the most basic information -- name, town, and telephone number -- about each person who applies to it

> for telephone service. This is "selection" of a sort, but it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression.

Id. at 1296. The Court further found that Rural only performed one act of coordination and arrangement -- Rural arranged its listings in alphabetical order -- but, again, found that this was not creative.

> Nor can Rural claim originality in its coordination and arrangement of facts. The white pages do nothing more than list Rural's subscribers in alphabetical order. This arrangement may, technically speaking, owe its origin to Rural; no one disputes that Rural undertook the task of alphabetizing the names itself. But there is nothing remotely creative about arranging names alphabetically in a white pages directory.

Id. at 1297. Based upon the fact that Rural's only acts of selection, coordination, and arrangement were the alphabetizing of all of its subscribers, the Court found the white pages directory to lack creativity, and, therefore, originality.

Beyond the Court's instruction as to what types of selection, coordination or arrangement are not creative and, therefore, not copyrightable, *i.e.*, Rural's selection to publish all of its subscribers in a single directory and Rural's arrangement of the listings for all of its subscribers in alphabetical order, there is little guidance in *Feist* as to how one determines if a minimal degree of creativity is present in any compilation.

C. This Court should grant *certiorari* to clarify the requirement of creativity as stated in *Feist* as being based upon clearly defined objective standards

This Court should grant *certiorari* in the present case to clarify the standard by which the minimal degree of creativity required in order to render a compilation copyrightable is measured. That standard should be one which extricates the courts from the morass of conflicting decisions and forum shopping which will result if originality is measured qualitatively, as was done by the court below.

This Court long ago recognized that "[i]t would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239,

251 (1903) (cited in *Feist*, 111 S. Ct. at 1294). Furthermore, this Court seemed to adopt such a "narrow" standard in *Feist* when it held that the mere mechanical task of alphabetization and selection of a comprehensive pre-existing group of listings was not sufficiently creative.

It is submitted that the types of "narrow and obvious limits" which do not yield creativity are those wherein (1) the material in a compilation is arranged in alphabetical, numerical or chronological order, (2) all of the elements of a pre-existing group are selected, (3) the selection, coordination and/or arrangement of the material is dictated by the nature of the material itself or by the idea of the work, rather than by the expression of the author. These standards may be objectively determined and will not lead a court into the impossible morass of attempting

to qualitatively evaluate creativity. Any contribution by an author which goes beyond these basic mechanical ways of selecting, coordinating or arranging the material contained in a compilation should be found by the courts as meeting the minimal degree of creativity required for originality.

II. THE EN BANC DECISION OF THE ELEVENTH CIRCUIT BELOW IN *DONNELLEY* HAS ESTABLISHED A DEGREE OF CREATIVITY WHICH IS BOTH TOO HIGH AND IS MEASURED BY SUBJECTIVE ANALYSIS

The district court below concluded that "BAPCO has created a unique directory due to its method of selecting, coordinating and arranging its material." Specifically, the district court found as follows:

> BAPCO performs various acts of selection which contribute to the publication of the directory. These acts include selection of the geographical area to be

covered by a directory; selection of the number of free listings to be provided; selection of the requirement that businesses use business telephone service in order to advertise in the BAPCO directory; selection by the sales force of the heading which will be recommended to a customer; selection of the classified headings which will be available for a particular directory; selection of the headings under which an advertiser's listing will appear; selection of the criteria under which advertisers may or may not be permitted to advertise under headings not related to their business; selection of the number of free listings to be provided telephone subscribers; selection of customers who will be contacted by premise sales, telephone sales personnel and no contact; and selection of the date of closing the directory. [Citation omitted].

BAPCO also engages in acts of coordination and arrangement which aid

> (sic., add) to the Yellow Pages publication. BAPCO coordinated headings. In addition, BAPCO arranged these headings, along with all of the listings under a particular heading, in alphabetical order. BAPCO chose to coordinate and arrange its directory in this manner from other alternatives. For example, BAPCO could have chosen to arrange its headings according to the number of advertisers or to arrange its listings under headings according to which listing had been advertising under that heading for the longest period of time.
>
> Donnelley does not dispute that BAPCO performs these acts. The dispute centers only on the legal effect of such acts.

BAPCO v. Donnelley, 719 F. Supp. at 1557-58. The panel opinion below affirmed this district court decision.

After rehearing en banc, the Eleventh Circuit overturned the unanimous panel

opinion. The majority rejected the district court's conclusion that BAPCO showed originality in selecting the scope for its directory, noting that every compilation "will by necessity have * * *, where applicable, a geographic limit selected by the compiler." *BAPCO v. Donnelley*, 999 F.2d at 1441. The majority also concluded that the various acts of selection that the district court and panel had found to be original were "not acts of authorship, but techniques for the discovery of facts." *Id.* The en banc Eleventh Circuit also ruled that BAPCO's coordination and arrangement of the particular listings under its selected headings failed to exhibit the requisite degree of creativity, because this general structure "did not deviate from the arrangement of the typical business directory." *Id.* at 1442n.13. The court further found that the selection of particular

headings did not constitute original expression warranting copyright protection." *Id.* at 1444.

The decision of the en banc Eleventh Circuit below sets a dangerous precedent for measuring creativity by comparing the work in question with other works of the same type. Such an analysis establishes a level of creativity corresponding to the novelty or obviousness standards of patent law. As this Court explicitly stated in *Feist*, novelty and obviousness are not the proper standard by which creativity should be measured. *Feist*, 111 S. Ct. at 1287.

Moreover, the foregoing demonstrates the importance of adhering to this Court's holding that the requisite level of creativity is "extremely low." *Feist*, 111 S. Ct. at 1287. Any other standard would require courts to make difficult -- indeed, impossible --

judgments about the relative value of various creative decisions. The majority below established a qualitative standard of creativity and its decision thus threatens to entangle the court in qualitative evaluations of creative worth.

The en banc decision of the Eleventh Circuit below is therefore in conflict with the Copyright Act of 1976 and with this Court's holdings in *Bleistein* and *Feist*. Accordingly, this Court should grant *certiorari* in this case.

III. THIS IS AN APPROPRIATE CASE FOR *CERTIORARI* SINCE THE REQUIREMENT OF CREATIVITY IS NOT LIMITED TO COMPILATIONS

The present case arises in the specific context of a yellow pages directory. Such works are treated as compilations under the copyright law. However, the requirement for

originality, and, thus, creativity, extends throughout the entire field of copyright. The Copyright Act defines the subject matter which qualifies for copyright protection as follows:

> Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:
>
> (1) literary works;
> (2) musical works, including any accompanying words;
> (3) dramatic works, including any accompanying music;
> (4) pantomimes and choreographic works;
> (5) pictorial, graphic, and sculptural works;

> (6) motion pictures and other audiovisual works;
> (7) sound recordings; and
> (8) architectural works.

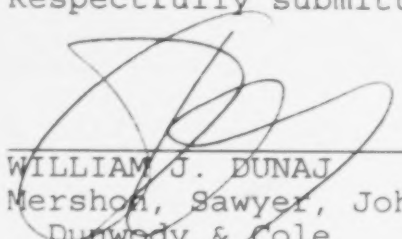
17 U.S.C. § 102(a)(emphasis added).

From this statute, it is clear that the requirement for originality applies to all types of copyrighted works; not merely compilations. Clarification as to how the minimal degree of creativity should be determined is an issue of importance to copyright law in general. Therefore, the present case is an excellent vehicle by which the Court clarify this important aspect of copyright law.

CONCLUSION

For the foregoing reasons, the Petition of BellSouth Advertising & Publishing Corporation should be granted.

Respectfully submitted,



WILLIAM J. DUNAJ
Mershon, Sawyer, Johnston, Dunwody & Cole
Suite 4500 Southeast
Financial Center
200 South Biscayne
Boulevard
Miami, FL 33131-2387
(305) 358-5100

Attorneys for Martindale-Hubbell, Inc.

CERTIFICATE OF SERVICE

We hereby certify that a true and correct copy of the printed version of the foregoing Motion for Leave to File Brief Amicus Curiae and Brief of Martindale-Hubbell, Inc. In Support of Petitioner BellSouth Advertising & Publishing Corporation has been forwarded to the Clerk of the United States Supreme Court via Federal Express Overnight Mail, and served, via Federal Express Overnight Mail, on Theodore C. Whitehouse, Esq., Willkie Farr & Gallaher, Three Lafayette Centre, 1155 21st Street, N.W., Suite 600, Washington, D.C. 20036-3302, this 6th day of January, 1994.

William J. Dunaj